

REMARKS

Claim 4 is cancelled. Claims 1 and 5 are amended. Claim 17 is new. No new subject matter is added. Claims 1-3, 5, and 16-17 are now pending in the application. Reconsideration and allowance of the pending claims is requested in light of the following remarks.

Claim Rejections Under 35 USC §103

Claims 1 and 4 were rejected under 35 USC 103(a) as being unpatentable over US Patent No. 6,587,231 to Sung (“Sung”), in view of US Patent No. 6,147,339 to Matsumoto (“Matsumoto”). The applicant respectfully disagrees, for the following reason.

Claim 1 is amended to include the subject matter of claim 4, and claim 4 is cancelled. Amended claim 1 now recites “a document cover coupled to the scanner housing assembly,” but Sung fails to teach or suggest that the optional cover 7 illustrated in FIG. 5 and FIG. 6 is in any way coupled to the transparent housing 1 (FIGS. 5 and 6; column 3, lines 52-55). Matsumoto also fails to teach or suggest this feature. For this reason, the combination of Sung and Matsumoto fails to establish *prima facie* obviousness for claim 1 because it does not teach or suggest all the features recited in the claim. MPEP 2143.03.

Claim 2 was rejected under 35 USC 103(a) as being unpatentable over Sung in view of Matsumoto as applied to claim 1 above, and further in view of US Patent No. 6,271,939 to Hu et al. (“Hu”). The applicant respectfully disagrees. Claim 2 is allowable at least because any claim that depends from a nonobvious independent claim is also nonobvious.

Claims 3, 5 and 16 were rejected under 35 USC 103(a) as being unpatentable over Sung in view of Matsumoto as applied to claim 1 above, and further in view of US Patent No. 6,327,047 to Motamed (“Motamed”). The applicant respectfully disagrees. Claims 3, 5, and 16 are allowable at least because any claim that depends from a nonobvious independent claim is also nonobvious.

Additionally, while the office action has explained why Motamed is considered to teach or suggest the feature of claims 3 and 5, namely, “a chart coupled to the document-loading panel” and “a chart coupled to the document cover,” respectively, it offers no explanation as to why Motamed also teaches the substantially different feature recited in claim 16, namely, “a chart formed on the document cover.” The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. MPEP 2142. If

the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. MPEP 2142.

New Claim 17


Claim 17 is allowable at least because any claim that depends from a nonobvious independent claim is also nonobvious.

Conclusion

For the foregoing reasons, reconsideration and allowance of claims 1-5 and 16 of the application as amended is requested. Please telephone the undersigned at (503) 222-3613 if it appears that an interview would be in advancing the case.

Respectfully submitted,

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